UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/769,919	02/03/2004	Thomas Muller	07781.0148	1898

22852   7590   06/14/2007

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER
HAILU, TESHOME

ART UNIT	PAPER NUMBER
2109	

MAIL DATE	DELIVERY MODE
06/14/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/769,919	MULLER, THOMAS
	Examiner	Art Unit	
	Teshome Hailu	2109	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 February 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-14</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-14</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>04 February 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>06/02/2004 and 10/05/2004</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-14 are pending.

Specification

2.   The disclosure is objected to because of the following informalities: On paragraph 15, the use of the trademark **"Java script"** has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Appropriate correction is required.

3.   The disclosure is objected to because of the following informalities: On paragraphs 30, 36, 43, 44 and 50, the use of the trademark **"Java applet"** has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Appropriate correction is required.

Claim Objections

1.   Claim 4 is objected to because of the following informalities: the short form HTML, XML and PDF should be write as HYPERTEXT MARKUP LANGUAGE (HTML), EXTENSIBLE MARKUP LANGUAGE (XML), PORTABLE DOCUMENT FORMAT (PDF). Appropriate correction is required.

Double Patenting

4.   The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.   A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g.,

In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re*

Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ

619 (CCPA 1970); and In *re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be

used to overcome an actual or provisional rejection based on a nonstatutory double patenting

ground provided the conflicting application or patent either is shown to be commonly owned with

this application, or claims an invention made as a result of activities undertaken within the scope

of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal

disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5.   Claims 1-14 are provisionally rejected on the ground of nonstatutory obviousness-type

double patenting as being unpatentable over claim 1-13 of copending Application No. 10/769,918.

Although the conflicting claims are not identical, they are not patentably distinct from each other

because claims 1-14 of the instant application substantially recite the limitations of claims 1-13 of

cited US application to examining electronic signatures or electronically signed documents.

Therefore, it would have been obvious to one of ordinary skill in the art of data processing at the

time the invention was made to modify the invention as claimed in the present application by

adding a pointer. Since an omission and addition of a cited limitation would have not changed the

process according to which the method and system as claimed. Therefore, the use of adding a

pointer on the present invention would be an obvious variation in the art for the purpose of

achieving the same end results of checking a digital document containing a digital signature and

would not interfere with the functionality of the steps previously claimed and would perform the

same function.

Claim Rejections - 35 USC § 101

6.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or
> composition of matter, or any new and useful improvement thereof, may obtain a patent
> therefor, subject to the conditions and requirements of this title.

7.   Claims 1-10 and 13 are directed to functional descriptive material, which consists of a

computer program per se that electronically signed documents with examination software. Since

a computer program by itself, (i.e., without computer readable and/or storable medium), is not a

process and does not fall within the statutory classes listed in 35 U.S. C. 101. The claims are

believed to recite non-statuary subject matter. The examiner has suggested that a computer

storable medium implementation needs to be added to the invention.

Claim Rejections - 35 USC § 102

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign
> country or in public use or on sale in this country, more than one year prior to the date of
> application for patent in the United States.

9.   Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown et al

(Brown), US PG PUBS 2003/0023850.

        As per claim 1, Brown discloses:

                - **A digital document containing a digital signature**, (page 1, paragraph 24, "*a*

digital signature for a sender of a message entry is attached to said message entry").

                - Wherein the document **includes a pointer** (page 3, paragraph 46, embedded

software programs that execute when they activates them by clicking on a link). According

to the invention page 11, paragraph 30 and figure 2, a pointer 204 is a link.

- a **piece of software for checking the digital signature**. (Page 4, paragraph

61, *a software application executing controls the process of attaching digital signature to*

a log file, also see figure 3).

As per claim 2, Brown discloses:

- wherein the pointer comprises **a hyperlink which points to a storage location**

of the software or contains **information about the storage location of the software which is**

able to be read by another program. (page 3, paragraph 46, "Web pages may further include

text, graphic images, movie files, and sounds as well as Java applets and other small embedded

software programs that execute when the user activates them by clicking on a link.").

Where a pointer 204 is a link as shown in figure 2 of the invention

As per claim 3, Brown discloses:

- wherein the digital document has a format for enabling the digital document to

be **displayed in a web browser**. (Page 3, paragraph 43, "A display 24 is also providing other

graphical representation formats.")

As per claim 4, Brown discloses:

- wherein the format is at least one of an **HTML, XML, or PDF** format. (page 3,

paragraph 46, "Documents (pages) on the web may be written in multiple languages, such as

Hypertext Markup Language (HTML) or Extensible Markup Language (XML), and identified

by Uniform Resource Indicators (URIs) that specify the particular messaging server 42 and

pathname by which a file can be accessed, and then transmitted from messaging server 42 to an

end user utilizing a protocol such as Hypertext Transfer Protocol (HTTP).")

As per claim 5, Brown discloses:

- The digital document of claim 1, wherein the *software is contained in digital*

document. (Page 4, paragraph 61, *a software application executing controls the process of*

attaching digital signature), where the logging controller software is attached to log file repository further explained in figure 3 of the drawing.

As per claim 6, Brown discloses:

- A method of **generating a digital document**, (Abstract, line 1-3, "saving *logfiles of a messaging session with the digital signatures of participants in the messaging session is provided."*)

- **Creating a digital signature for an original document**: (page 2, paragraph 35, "A *"digital signature" may encompass multiple types of encryption methods utilized to verify the authenticity of signatures and the integrity of documents."*)

- **generating a digital document from the original document**: (Abstract, line 1-3, "saving logfiles of *a messaging session with the digital signatures of participants in the messaging session is provided."*)

- adding to the digital document the digital signature and **a pointer to a pieces of software for checking the digital signature**. (Page 4, paragraph 61, "Logging controller *controls the process of obtaining and attaching digital signature to a log file."*), where the logging controller software is attached to log file repository further explained in figure 3 of the drawing. Moreover, (page 3, paragraph 46, "Web pages may further include text, graphic images, movie files, and sounds as well as Java applets and other small embedded *software programs that execute when the user activates them by clicking on a link."*). Where a pointer 204 is a link as shown in figure 2 of the invention.

As per claim 7, Brown discloses:

- A method for checking a digital document **containing a digital signature,** wherein the document comprises **a pointer to piece of software for checking the digital signature**, the method comprising: **executing the software contained in the document**. (Page 4, paragraph 61, "Logging controller controls the *process of obtaining and attaching digital*

signature to a log file."), where the logging controller software is attached to log file repository

further explained in figure 3 of the drawing.

As per claim 8, Brown discloses:

- executing and loaded software. (Page 4, paragraph 61, "Logging controller

controls the process of obtaining and attaching digital signature to a log file.")

As per claim 9, Brown discloses:

- The method of claim 6, wherein the original document **comprising of digital

faxes**. (page 1, paragraph 12, "One type of electronic communication is supported by messaging

which includes the use of computer systems and data communication equipment to convey

messages from one person to another, *as by e-mail, voice mail, unified messaging, instant

messaging or fax."*), according to the invention, paragraph 14, stated that a document within the

meaning of an embodiment of the invention is an electronic or digital *file having any content*.

As per claim 10, claim 10 is rejected under the same reason as claim 1.

As per claim 11, Brown discloses:

- A computer system for **generating a digital document containing a digital

signature**, (Abstract, line 1-3, "*a messaging session with the digital signatures of

participants in the messaging session is provided.*")

- wherein the document comprises **a pointer** (page 3, paragraph 46, embedded

software programs that execute when they activates them by clicking on a link). According

to the invention page 11, paragraph 30 and figure 2, a pointer 204 is a link.

- **to a software for checking the digital signature**, (Page 4, paragraph 61, *a software

application executing controls the process of attaching digital signature*).

- means for **storing data**; means for **storing programs**; means for **executing program**;

(Page 3, paragraph 40, "The present invention may be provided as a computer ***program***

product, included on a machine-readable medium having stored thereon the machine

executable instructions used to program computer system 10 to perform a process according to

the present invention.")

    - program code means for performing a method of generating a digital

document (Abstract, line 1-3, *"program for saving logfiles of a messaging session with the*

digital signatures of participants in the messaging session is provided.")

    - when executed by the means for executing programs, (Page 3, paragraph

40, "a computer program product, *included on a machine-readable medium having stored*

thereon the machine executable instructions used to program computer system 10 to perform

a process according to the present invention.")

    - creating a digital signature for an original document; generating a digital

document from the original document; (Abstract, line 1-3, "saving logfiles of a *messaging*

session with the digital signatures of participants in the messaging session is provided.")

    - adding to the digital document the digital signature and a pointer to

software for checking the digital signature. (Page 4, paragraph 61, *a software application*

executing controls the process of attaching digital signature), moreover, (page 3, paragraph

46, embedded *software programs that execute when they activates them by clicking on a*

link). According to the invention page 11, paragraph 30 and figure 2, a pointer 204 is a link.

    As per claim 12, Brown discloses:

    - A computer program stored on a computer readable medium, product

comprising program code means for performing a method of *generating a digital document*

(Abstract, line 1-3, "a program for saving logfiles of a *messaging session with the digital*

signatures of participants in the messaging session is provided.")

    - when **executed on a computer,** (Page 3, paragraph 40, "a computer program

product, included on a machine-readable medium having stored thereon the machine *executable*

instructions used to program computer system 10 to perform a process according to the present

invention.")

> - *creating a digital signature for an original document; generating a digital document from the original document;* (Abstract, line 1-3, "saving logfiles of a messaging session with the *digital signatures of participants in the messaging session is provided."*)

> **- adding to the digital document the digital signature and a pointer to software for checking the digital signature.** (Page 4, paragraph 61, *a software application executing controls the process of attaching digital signature*).

As per claim 13, Brown discloses:

> **- An electrical carrier signal embodying a computer program for performing the method of generating a digital document.** (page 3, paragraph 42, "ISP 37 and *Internet 38 both use electrical, electromagnetic, or optical signals that carry digital data streams."*)

As per claim 14, Brown discloses:

> - A computer program product comprising program code means which are stored on a **computer-readable medium, the program code means comprising program instructions for performing the method of generating a digital document of claim 6 when executing on a computer.** (Page 3, paragraph 40, "a computer program product, included on a *machine-readable medium having stored thereon the machine executable instructions used* to program computer system 10 to perform a process according to the present invention.")

> -

Conclusion

10.   The prior art made or record and not relied upon is considered pertinent to applicant's disclosure

TITLE: Verifying messaging sessions by digital signatures of participants, US Pub. No. 20030023850.

TITLE: Method for using pointers for pointing to examination software when generating and examining electronic signatures or electronically signed documents, US Pub. No. 2004/0205346.

TITLE: Transaction method and system for data networks, like Internet, US 6,889,325.

TITLE: Ensuring the integrity of an electronic document, US Pub. No. 2003/0028774.

TITLE: License-based cryptographic technique, particularly suited for use in a digital rights

management system, for controlling access and use of bore resistant software objects in a client

computer, US 6,898,706.

TITLE: Method for identifying and obtaining computer software from a network computer using a

tag, US 6,256,668.

TITLE: Negotiated wireless peripheral systems, US 6,965,914.

TITLE: System and methods for matching, selecting, narrowcasting, and/or classifying based on

rights management and/or other information, 6,112,181.

Any inquiry concerning this communication or earlier communications from the examiner should

be directed to Teshome Hailu whose telephone number is (571) 270-3159. The examiner can

normally be reached on Mon-Fri 7:30a.m. to 5:00p.m. PST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Chamili Das can be reached on (571) 272-3696. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system,

see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Teshome Hailu

TH

Patent Examiner, Art Unit 2109

CHAMELI DAS
SUPERVISORY PATENT EXAMINER

6/8/07